

flap 16, and zipper closure 11 of the Bourdeau et al. patent in the lateral position on the glove of the '419 patent to facilitate its donning and removal. The Examiner further alleges that Figure 2 in the '419 patent shows the sleeve geometries recited in claims 5 and 6. The Examiner finally alleges that the discrete finger opening recitation on line 9 in claim 1 does not obviate the plurality of finger digits opening disclosed in the '419 patent.

Claim 1 as amended includes the limitation that all of the wearer's fingers extend through a single discrete digit. In contrast, the '419 patent discloses four individual digit openings. Therefore, the '419 does not disclose all the elements of claim 1 as amended. As such, claim 1 is not made obvious by the '419 patent in view of the Bourdeau et al. patent. Therefore, claim 1 (amended) is in allowable form.

Because claim 1 (amended) is in allowable form, claims 2, 5 and 6, which were also rejected over the '419 patent in view of the Bourdeau et al. patent and which depend from claim 1 (amended), are also in allowable form. Reconsideration and allowance of claims 1 (amended), 2, 5 and 6 are respectfully requested.

The Examiner then rejected claims 1, 2, 5, and 6 under 35 U.S.C. § 103(a) as being patentable over Elliott U.S. Patent No. 2,904,792 ("792 patent") in view of the Bourdeau et al. patent. The Examiner's statement alleges that it would be obvious to a person of ordinary skill in the glove making art at the time of the invention to replace the series of aligned apertures and a cord in the glove with the zipper of the Bourdeau et al. patent to provide a more secure closing of the glove of the '792 patent. The Examiner also alleges that Figure 1 of the '792 patent discloses a plurality of fingers passing through the single discrete digit opening.

Applicant respectfully disagrees with the Examiner that claims 1 (amended), 2, 5 and 6 are obvious over the '792 patent in view of the Bourdeau et al. patent. An element of claim 1 as amended is discrete digit opening disposed at another end of the sleeve wherein all of the wearer's fingers extend therethrough, wherein the sleeve extends to a point adjacent to a first set of joints of the wearer's fingers, leaving the joints exposed. This element defines the sleeve as extending up to, but leaving the knuckles of the digits of the hand exposed. In contrast, the '792 patent discloses that

"the sleeve is also flared outwardly towards an outer end where the enlarged portion 6 extends beyond the knuckles to the adjacent finger joints and is shaped to receive the wearer's hand." (Column 2, lines 4-8).

The '792 patent in view of the Bourdeau et al. patent does not teach each element of claim 1 (amended). Therefore, claim 1 (amended) is not obvious over the '792 patent in view of the Bourdeau et al. patent. Reconsideration and allowance of claim 1 (amended) is respectfully requested.

Claims 2, 5 and 6 depend from claim 1 (amended) and are also believed to be in allowable form because claim 1 (amended) is in allowable form. Reconsideration and allowance of claims 2, 5 and 6 are also respectfully requested.

The Examiner also rejected claims 1 and 3 as being obvious under 35 U.S.C. § 103(a) over the Matthews U.S. Patent No. 5,402,536 ("536 patent") in view of the Bourdeau et al. patent alleging that it would be obvious to a person of ordinary skill in the art to include the zipper disclosed in the Bourdeau et al. patent on the side of the glove disclosed in the '536 patent. Furthermore, the Examiner alleges that Figure 3 in the '536 patent shows the sleeve length arrangement of claim 3.

Applicant respectfully disagrees with the Examiner that claim 1 (amended) is obvious over the '536 patent in view of the Bourdeau et al. patent. Claim 1 (amended) includes as an element a discrete digit opening disposed at another end of the sleeve wherein all the wearer's fingers extend therethrough wherein the sleeve extends to a point adjacent to the first set of joints of the wearer's fingers, leaving the joints exposed.

In contrast, the '536 patent discloses individual finger openings. "The two halves are then placed with the moisture absorbing sides 3 and 7 opposing each other and attached together by closure means at 22, 24, 26, 28, 30 and 32 in Fig. 2 leaving the finger openings 33, 34, 36, 38 or the pinky, ring, middle and four fingers respectively, a thumb opening 40 and the forearm opening 42." (Col. 3, lines 21-25). Therefore, the '536 patent discloses individual digit openings for the individual

digits. Furthermore, referring to Figure 3 of the '536 patent, the glove is shown to extend up to the first set of joints of the phalanges of the digits or the fingers.

In contrast, the hand and forearm protector defined in claim 1 (amended) defines that the protector extends up to the first set of joints of the wearer's fingers leaving the joints exposed. These joints are the knuckles of the digits. In contrast, the glove disclosed in the '536 patent shows the knuckles of the wearer's digits being covered by the glove. Therefore, the '536 patent in view of the Bourdeau et al. patent does not disclose each and every element of claim 1 (amended). As such, the '536 patent in view of the Bourdeau et al. patent does not make claim 1 (amended) obvious. Claim 1 (amended) is allowable form. Reconsideration and allowance of claim 1 (amended) is respectfully requested. Because claim 3 (amended) depends from claim 1 (amended), claim 3 (amended) is also believed to be in allowable form. Reconsideration and allowance of claim 3 (amended) is respectfully requested.

#### Recapture Argument

The Examiner then rejected claims 1-6 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). The Examiner alleges that the cancellation of lines 11-15 and 17-19 in patent claim 1 amended constitutes the broadening aspect since these lines were added in the original patent claim 1 to define over the '792 patent and the '419 patent.

Applicant respectfully disagrees with the Examiner that the amendment of claim 1 is a recapture of surrendered subject matter. Claim 1 as allowed in the Kast U.S. Patent No. 5,878,435, the patent which is the subject of this reissue application, defines the hand and forearm protector as extending past the set of joints of the metacarpal and the phalanges to a point adjacent to a joint of the phalanges. Additionally, the discrete thumb opening was defined as extending

beyond the point of the phalanges and first metacarpal and being adjacent to the joint of the phalanges leaving that joint exposed.

Applicant's attorney, inadvertently and without any deceptive intent, claimed subject matter which was not supported by the specification. Specifically, the specification states that "The sleeve 12 of the hand and forearm protector extends up to each of the fingers first set of joints or knuckles 47, 49, 51 and 53. The first set of joints of the fingers 46, 48, 50 and 52 are defined as those joints or knuckles that are formed at the articulation of the metacarpal bone and the phalange of each finger. The sleeve 12 does not extend over the joints or knuckles 47, 49, 51 and 53 thereby exposing those knuckles as best illustrated in Fig. 1 wherein the edge 54 lies directly adjacent to the exposed knuckles 47, 49, 51 and 53." (Col. 3, lines 11-20) Claim 1 defined the hand and forearm protector having a digit opening extending over the knuckles and up to the first set of joints of phalanges. The specification defines the hand and forearm protector extending up to the knuckles but leaving the knuckles exposed. Therefore, claim 1 claims subject matter which was not supported by the specification and as such claimed more than applicant was entitled to claim, thereby creating a 35 U.S.C. § 112 paragraph 1 issue.

The subject matter defining the forearm protector extending past the knuckles and up to the first set of phalanges does not exist in the specification and therefore was not available to be surrendered. As such, this reissue is not an issue of recapture, but rather an issue of having claimed more than what was allowed because more was claimed than was supported by the specification.

Similarly, claim 1 defined a thumb opening extending beyond the joint of the metacarpal and phalange and extending up to the joint of the phalanges but leaving that joint exposed. Again, the specification does not support such a claim. "Similarly, the thumb opening 18 has an edge 55 that is disposed to extend the sleeve to a position such that the first joint or knuckle of the thumb that is formed between the metacarpal bone and the phalange is exposed" (Col. 3, lines 21-25). Again the subject matter claimed which defines the thumb opening of the hand and forearm protector extending up to the joint of the phalanges is not supported by the specification. Again this

is not an issue of recapture but rather an issue of claiming more than was supported by the specification.

Claim Rejection 35 U.S.C. § 112

The Examiner rejected claim 3 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claim 3 to more distinctly claim the invention per the Examiner's suggestion. As such, applicant respectfully requests that the rejection of claim 3 be withdrawn.

Drawings

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) as not showing every feature of the invention specified in the claims. Specifically, the Examiner alleges that the decorative indica recited in claim 4 is not shown or featured in the drawings.

Applicant respectfully disagrees with the Examiner that the decorative indica is not present on the drawings. Indica by definition is a distinctive mark that indicates. *Merriam-Webster's Third New International Dictionary of the English Language Unabridged*, Merriam-Webster Pub. Co., P. 1150 (1986) (Exhibit A). Figures 1, 2, 5 and 6 each show markings on the sleeve. Therefore, indica is present in the drawings. As such, claim 4 is supported by the drawings. Applicant respectfully requests that the objection to claim 4 be withdrawn.

Miscellaneous Reissue Matters

Regarding the miscellaneous reissue matters, the applicant is submitting a supplemental oath which states that there are no assignees to this invention. The rejection or objection to paragraph 3 of the Declaration associated with the specifications has been amended to overcome the objection under MPEP 601.01(a). Furthermore, the changes of the Certificate of Correction have been entered into the original reissue application. A formal request for transferred drawings is hereby being made with this Amendment and Response. Additionally, applicant's Declaration has been modified in paragraph 9 and specifically line 2 to substitute the word "extent" for the word "extend".

Regarding Examiner's inquiry to applicant's attorney as to why material deleted from the patent claim 1 is not supported by lines 8-24 in column 3 of the specification, applicant respectfully requests that Examiner refer to the portion of the response addressing why there is no recapture of surrendered subject matter.

CONCLUSION

For the above and foregoing reasons, claims 1-6 are believed to be in allowable form. Reconsideration and allowance of claims 1-6 are respectfully requested.

Respectfully submitted,

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**APPENDIX:  
MARKED UP VERSION OF SPECIFICATION AND CLAIM AMENDMENTS**

1.(Amended) A hand and forearm protector comprising:

- a sleeve for overlying a forearm and a proximal hand portion of a wearer;
- a primary opening at one end of the sleeve;
- a discrete digit opening disposed at another end of the sleeve wherein all of the wearer's fingers extend therethrough, wherein the sleeve extends to a point adjacent a first set of joints of the wearer's fingers, leaving the joints exposed;
- a discrete thumb opening disposed at another end of the sleeve;
- a longitudinal opening along the sleeve extending adjacent from a point that overlies a juncture of the carpal bones and the radius and extending rearwardly towards the primary opening to proximately the end of the sleeve; and
- a zipper for closing the longitudinal opening to conform the sleeve to the forearm of the wearer, the closure being disposed to overlie a forward side of the forearm.

3. (Amended) The protector of claim 1 wherein [the sleeve extends to] the length of the sleeve is selected to extend to approximately 1 to 1½ inches from an elbow of the wearer.